

## **REMARKS**

Claims 1-20 are pending in this application. Of these pending claims, Claims 1-20 stand rejected. By way of this paper, Claims 1 and 18 have been amended.

The foregoing amendments and following remarks are believed to be fully responsive to the outstanding office action, and are believed to place the application in condition for allowance.

### **Claim Rejections - 35- U.S.C. § 112**

Claims 1 and 18 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These rejected claims have been amended to overcome the formalities issues. The scope of the claims have not been altered, and no new issues have been introduced.

### **Claim Rejections – 35 U.S.C. § 103**

Claims 1, 2, 11-14, and 16-19 are rejected under 35 U.S.C 103(a) as being unpatentable over Smith (2003/0172072) further in view of Haines (6,295,423). Claims 3-6 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (2003/0172072) in view of Haines (6,295,423) and further in view of Martin et al. (5,809,479). Claims 9, 10, 15, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (2003/0172072) in view of Haines (6,295,423) and further in view of Aoyama et al. (2004/0172341).

Referring to section 5 of the Final Office Action, the Examiner admits that Smith “fails to disclose...[a] computational element [that] provides a dormancy feature....” The Examiner continues by suggesting that it would have been obvious to combine the threshold-defining mechanism of Haines. However, the Examiner does not suggest that Haines includes a dormancy feature that would allow an item and its associated parameter to be placed in a dormant state so that the parameter associated with the dormant item does not become a trigger point for the tracking device to generate an order for the dormant items.

In fact, Haines does not teach that the monitoring system goes dormant for any particular item. Rather, Haines teaches only that the threshold value at which an item’s parameter triggers an event can be user-manipulated to define a new

threshold value for the monitoring mechanism. In this way, the system is flexible so that users can set their own thresholds for determining when a consumable component is approaching the end of its useful lifetime. There is no disclosure of placing the item being monitored in a dormant state so that no signal is generated at all.

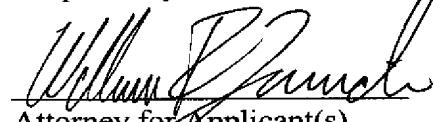
Assuming arguendo that the references might be capable of combination, there is at least one limitation in the claimed invention that is not disclosed by the references individually or in combination. The Smith fails to disclose a dormancy feature that would allow an item and its associated parameter to be placed in a dormant state so that the parameter associated with the dormant item does not become a trigger point for the tracking device to generate an order for the dormant items. Haines fails to disclose the information undisclosed by Smith. To establish *prima facie* obviousness, all the claim limitations must be taught or suggested by the prior art. *See* MPEP 2143.03. It is well established in the law that, for a proper *prima facie* rejection of a claimed invention on the basis of obviousness under 35 U.S.C. 103, the references relied upon must teach every element of the claimed invention. "Each element of a claim is material." *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 227 USPQ 657,666 (Fed. Cir., 1985).

### CONCLUSION

It is respectfully submitted that, in view of the above amendments and remarks, this application is now in condition for allowance, prompt notice of which is earnestly solicited.

The Examiner is invited to call the undersigned in the event that a phone interview will expedite prosecution of this application towards allowance.

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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.